

Attorney's Docket: 1999DE607  
Serial No.: 10/070,071  
Art Unit: 1623

### REMARKS

The Office Action mailed April 23, 2003, has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. The amendments made herein are fully supported by the Application as originally filed. No new matter has been added. Accordingly, reconsideration of the present Application in view of the above amendments and following remarks is respectfully requested.

### CLAIM STATUS

Claims 1-17 are pending in this Application. By this Amendment, the claims have been amended to eliminate improper multiple dependent claims, and have been edited to further clarify the subject matter which Applicant regards as the invention. New claim 18 has been added to further particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Therefore, the claims under consideration are believed to include claims 1-18.

### Abstract

The Office states that the Application does not contain an abstract of the disclosure. An Abstract is enclosed herewith.

### Objection to Disclosure

The disclosure stands objected to as the Office is of the opinion that pages 14-16 of the specification appear to be missing since the last page of the specification is 13 and the claims begin on page 17.

All pages of the specification and claims are present, however, a typographical error was made in the Article 34 amendments submitted with the original application, with the amended pages beginning on page 17 rather than page 14. Thus, the amended sheets should be rewritten as pages 14-16. If the Office

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desires Applicant to submit substitute pages for this typographical error, please so advise.

Improper Multiple Depending Claims

Claims 4-12, 16 and 17 are objected to under 37 CFR § 1.75(c) as being improper multiple dependent claims. Claims 4-12, 16 and 17 have been amended, placing the same in proper form.

Claim Objections

Claim 1 stands objected to as the Office is of the position that in claim 1, line 4, the phrase "in that" should be deleted. Such phrase has been deleted.

Claim Rejections Under 35 USC § 102

Claims 13-15 stand rejected under 35 USC § 102(b) as being anticipated by Kobayashi et al. (European Patent No. 497,985). This rejection is respectfully traversed.

Applicant's invention, as defined by independent claim 13, is directed to a methylhydroxypropylcellulose having characteristics including "a particle size distribution in which the proportion of particles with a size of <125  $\mu$ m does not exceed 50%".

Kobayashi et al., in contrast, discloses a coating base for pharmaceutical films wherein the cellulose ether is ground to an average particle size in the order of 50  $\mu$ m. See, *inter alia*, page 5, lines 5-7, 11-13, and 20-23.

A *prima facie* rejection under 35 USC § 102 requires the prior art reference to disclose each and every aspect of an applicant's claimed invention. Here, such *prima facie* case is wanting. It is clear from the disclosure of Kobayashi et al. that such reference does not teach, disclose, or suggest a methylhydroxypropylcellulose having a "particle size distribution in which the proportion of particles with a size of < 125  $\mu$ m does not exceed 50%". Simply put, the prior art's reliance upon an average particle size of 50  $\mu$ m prevents such reference from disclosing, or teaching the

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limitation recited in Applicant's claim. It is, therefore, respectfully submitted that claim 13, and all claims depending therefrom, are not anticipated by Kobayashi et al.

Claim Rejections Under 35 USC § 103

Claims 1-3 stand rejected under 35 USC § 103(a) as being unpatentable over Ouno et al. (US Patent No. 3,391,135) in view of Savage (US Patent No. 3,728,331). This rejection is respectfully traversed.

The Office states that in Example II, Ouno et al. disclose a process for preparing low molecular weight methyl-hydroxypropyl cellulose and further states that the process of Applicant's claim differs from the Ouno et al. process "by claiming the addition of oxidizing agents to the slurry, before, during and/or after the depolymerization." The Office employs the Savage reference as the Office is of the opinion that such reference "shows the use of hydrogen peroxide . . . in a process to depolymerize or reduce the viscosity of cellulose ethers."

The Office then concludes:

One would be motivated to combine the teachings of Ouno and Savage patents in a rejection of the claims under 35 USC § 103 since both patents disclose procedures for depolymerizing or reducing the viscosity of cellulose ethers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine with the process of using an acid (hydrogen chloride) to depolymerize cellulose ethers as set forth in the Ouno et al. patent, process steps that involve treating the cellulose ether with an oxidizing agent (hydrogen peroxide). In view of the recognition in the art, as evidenced by the Savage patent, that such a procedure result in high yields and a readily controlled viscosity reduction.

It is respectfully contended that the Office has not established a *prima facie* case of obviousness of claims 1-3 by the combination of Ouno et al. in view of Savage. Applicant is of the position that there exists no motivation for one with ordinary skill in art to combine the Ouno and Savage patents as suggested by the Office.

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In order to substantiate a § 103 rejection, the Office must refer to some suggestion or motivation in the prior art, leading the ordinary artisan to combine the references in a manner which arrives at an applicant's claimed invention. Importantly, such motivation is lacking when the references specifically teach away from the proposed combination. Such teaching away is readily apparent in this case.

An examination of Ouno et al. reveals with abundant clarity that its process is to be conducted in the absence of oxidative agents. Specifically, in column 2, lines 26-28, the Ouno et al. reference states:

Another object of the invention is to provide a process of the indicated kind which does not make use of oxidation agents or mechanical cleavage processes . . .

It is clear that the Ouno et al. reference specifically teaches not using oxidative agents. In consequence, one with ordinary skill in the art, contemplating the Office's proposed modification, would first necessarily have to abandon the express teaching of Ouno et al. which calls for a process in the absence of oxidation agents. As a result, an ordinary artisan has an express disincentive to employ the modification proposed by the Office, as it is said in column 2, lines 6-7 of Ouno et al. that "oxidizing agents customarily results in undesired side effects which seriously affect the success of the operation." In view of the fact that Ouno et al. specifically teaches away from the use of oxidation agents in its process, it is contended that any motivation for one with ordinary skill in the art to arrive at Applicant's claimed invention is gained by use of impermissible hindsight based upon a knowledge of Applicant's disclosure. For this reason, Applicant is of the position that claims 1-3 are not made obvious by any combination of Ouno et al. in view of Savage, and, therefore, prays for reconsideration and withdrawal of the rejection.

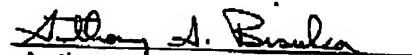
As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However if an additional fee is required, the

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Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 03-2060.

In view of the forgoing amendments and remarks, the present application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, he/she is requested to contact the attorney for Applicant at the telephone number provided below.

Respectfully submitted,

  
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